

Attorney's Docket No: A-2456

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By: [Signature]

Date: November 11, 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 09/626,312 Confirmation No.: 7920
Inventor : Franck Bausela et al.
Filed : July 26, 2000
TC/A.U. : 3724
Examiner : Omar Flores-Sánchez
Customer No.: 24131

Hon. Commissioner for Patents
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. 1.181 AND
REQUEST FOR REFUND

Sir:

Appellants respectfully request that the *Substitute Brief on Appeal* filed May 28, 2004 be accepted as proper and that the amount of \$1,530.00 for a four-month extension fee submitted with a *Substitute Brief on Appeal* on October 13, 2004 be refunded to counsel for the following reasons.

Background:

- Appellants submitted a *Notice of Appeal* on December 24, 2003, which was filed in the PTO on December 29, 2003.
- A *Brief on Appeal* was timely submitted within two months from the date of submission of the *Notice of Appeal*, and filed in the Patent Office on February 27, 2004.

- In reply to the *Notice of Non-Compliance* dated May 13, 2004, appellants submitted a *Substitute Brief on Appeal* on May 26, 2004, which was filed in the PTO on May 28, 2004.
- Appellants then received an Office communication dated September 24, 2004, stating that appellants had not fulfilled the requirements set forth in the *Notice of Non-Compliance* in the *Substitute Brief on Appeal*, and that the period for response continues from the mailing date of the *Notice of Non-Compliance*, thus from May 13, 2004.
- Consequently, appellants submitted another *Substitute Brief on Appeal* on October 13, 2004 with a four-month extension fee of \$1,530.00, which was filed in the PTO on October 15, 2004.

Arguments:

- In the Office communication dated September 24, 2004, the Examiner has stated that "Applicant establishes three separate groups, but does not argue why each group is separately patentable, as per 37 CFR 1.192(c)(7)." It is noted that 37 CFR 1.192(c)(7) requires appellant to explain in the argument why the claims of a group are believed to be separately patentable, but not why each group is separately patentable.
- In the Office communication dated September 24, 2004, the Examiner has further stated that "A unique argument must be given for each group." This requirement is not known to appellants and cannot be found in the patent laws, the patent rules, or the MPEP. 37 CFR 1.192(c)(7) only requires appellants to explain why the claims of a group are believed to be separately patentable, but not to provide "a unique argument" for each group. The requirement of "a unique argument" for each group also cannot be found in 37 CFR 192(c)(8)(iv) cited by the Examiner. 37 CFR 192(c)(8)(iv) only describes the general requirement for arguments against rejections under 35 USC 103.

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- Appellants see no reason why, if multiple claims contain the same feature which is believed to be patentable, the same argument cannot be repeated, with separate headings, as was done in this appeal.
- In addition, the Examiner has stated in the Office communication dated September 24, 2004 that the period for response continues from the mailing date of the Notification of Non-Compliance, May 13, 2004. Appellants believe that this requirement is not justified for two reasons: (1) The *Substitute Brief on Appeal* submitted on May 26, 2004 constitutes a good faith effort by appellants to comply with the Notification of Non-Compliance; (2) The Office communication dated September 24, 2004 was issued almost four (4) months after the *Substitute Brief on Appeal* had been received by the Patent Office on May 28, 2004. It is unconscionable to require appellants to be burdened with the extension fee when the Office could have notified appellants soon after receiving the *Substitute Brief on Appeal* on May 28, 2004.
- Finally, it is noted that the requirement for the item "grouping of claims" in the brief, as per 37 CFR 1.192(c)(7), has been deleted from the new rule 37 CFR 41.37, which replaces the old rule 37 CFR 1.192.

In view of the foregoing, counsel respectfully requests that the amount of \$1,530.00 be credited to counsel's Deposit Account No. 12-1099 of Lerner and Greenberg, P.A.

Respectfully submitted,



For Appellants

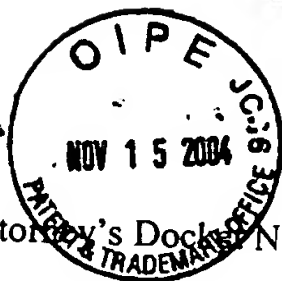
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Date: November 11, 2004

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